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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/512,013	10/19/2004	Stephen John Coughlin	11/2-22652/A/MA 2220/PCT	1955
324	7590	06/13/2005	EXAMINER GREEN, ANTHONY J	
CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			ART UNIT 1755	PAPER NUMBER

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/512,013

Applicant(s)

COUGHLIN ET AL.

Examiner

Anthony J. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22, 26, 27, 38-40, 42, 44 and 45 is/are rejected.
- 7) ☒ Claim(s) 23-25, 28-37, 41 and 43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/14/2005</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The preliminary amendment submitted on 19 October 2004 has been entered. Currently claims 1-45 are pending.

### ***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The term "liquid pigment composition" found in claims 27, 29 and 34.

3. The abstract of the disclosure is objected to because it is not found on a separate sheet free of extraneous material. Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

4. A series of singular dependent claims is permissible in which a dependent claim refers to a **preceding** claim which, in turn, refers to another preceding claim. Note that applicant has claim 24 depending from claim 25 (which comes after) and claim 26 depending from claim 27 (which comes after).

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind

that a dependent claim may refer to any preceding independent claim. See MPEP § 608.01(n).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 44-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 44 and 45 the phrase "the said anionic and cationic coloured compounds and their complexes" lacks proper antecedent basis

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 56-005552A. Note: The examiner has requested a formal translation of this document in order to find out what types of dyes are discussed in the specification. A copy of the translation will be forwarded to applicant upon receipt by the examiner.

The reference teaches, in the abstract, perylene pigment particles which are coated with a cationic dye and an anionic dye.

The instant claim is met by the reference.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-22, 26-27, 38-40, 42 rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US Patent No. 6,672,717).

The reference teaches, in column 9, lines 17+, the formation of a first ink and a second ink wherein at least one of them contains a colorant. The colorant may be a dye, a pigment or a mixture thereof. Column 9, lines 19+, recites many different dyes usable which include anionic, cationic, nonionic, zwitterionic dyes etc. Column 10, lines 35+ recite that mixtures of dyes may be utilized. Column 10, lines 42+ recite the types of pigments that are usable in the invention which include various organic pigments.

The instant claims are obvious over the reference. While the reference does not provide an example wherein a composition comprising an organic pigment in combination with at least one anionic and at least one cationic coloured compound, it does teach that one may be formulated. Accordingly one of ordinary skill in the art would have found it obvious to produce a composition comprising an organic pigment in

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combination with an anionic dye and a cationic dye as such a composition is suggested by the reference. As for the types of pigments utilized (claims 2-4 and 38-39), the reference in column 10, lines 42+ recite examples of various pigments that encompass those instantly claimed. As for the pigments recited in instant claims 5, 7-9 and 40 the reference teaches that other pigments may be selected and accordingly one would find it obvious to use other pigments not particularly exemplified by the reference. Note also that the reference broadly teaches that the pigment is red, green, blue, brown, magenta, cyan, and yellow as well as mixtures thereof (column 10, lines 44-45). While the use of the specific mono or disazo pigment recited in claim 6 is not specifically taught, since the reference teaches that various diarylide pigments may be utilized it would have been obvious to use any well known diarylide pigment in the composition of the reference absent evidence showing otherwise. While the use of the various pigments recited in instant claims 10-11 are not specifically taught since the reference teaches that various phthalocyanine pigments may be utilized it would have been obvious to use any well known phthalocyanine pigment in the composition of the reference absent evidence showing otherwise. As for the dyes recited in claims 12-20 the reference suggests many different dyes that may be utilized which include some of those recited in the instant claims. For the ones not specifically mentioned since the reference teaches that various dyes may be utilized it would have been obvious to utilize any well known dye in the composition of the reference absent evidence showing otherwise. As for claim 21 this is not a required component as it is merely clarifying what component (2b) may be selected from. As for claim 22 this is met by the reference as the reference

suggests mixtures of anionic and cationic dyes. Claims 26-27 are met by the reference as the reference teaches the formation of an aqueous ink vehicle composition.

11. Claims 1-22, 26-27, 38-40, 42 rejected under 35 U.S.C. 103(a) as being unpatentable over Colt (US Patent No. 6,123,758).

The reference teaches, in column 5, lines 23+, the formation of an ink containing a colorant. The colorant may be a dye, a pigment or a mixture thereof. Column 5, lines 25+, recites many different dyes usable which include anionic, cationic, nonionic, zwitterionic dyes etc. Column 6, lines 40+ recite that mixtures of dyes may be utilized. Column 6, lines 47+ recite the types of pigments that are usable in the invention which include various organic pigments.

The instant claims are obvious over the reference. While the reference does not provide an example wherein a composition comprising an organic pigment in combination with at least one anionic and at least one cationic coloured compound, it does teach that one may be formulated. Accordingly one of ordinary skill in the art would have found it obvious to produce a composition comprising an organic pigment in combination with an anionic dye and a cationic dye as such a composition is suggested by the reference. As for the types of pigments utilized (claims 2-4 and 38-39), the reference in column 6, lines 47+ recite examples of various pigments that encompass those instantly claimed. As for the pigments recited in instant claims 5, 7-9 and 40 the reference teaches that other pigments may be selected and accordingly one would find it obvious to use other pigments not particularly exemplified by the reference. Note also

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that the reference broadly teaches that the pigment is red, green, blue, brown, magenta, cyan, and yellow as well as mixtures thereof (column 6, lines 49-50). While the use of the specific mono or disazo pigment recited in claim 6 is not specifically taught, since the reference teaches that various diarylide pigments may be utilized it would have been obvious to use any well known diarylide pigment in the composition of the reference absent evidence showing otherwise. While the use of the various pigments recited in instant claims 10-11 are not specifically taught since the reference teaches that various phthalocyanine pigments may be utilized it would have been obvious to use any well known phthalocyanine pigment in the composition of the reference absent evidence showing otherwise. As for the dyes recited in claims 12-20 the reference suggests many different dyes that may be utilized which include some of those recited in the instant claims. For the ones not specifically mentioned since the reference teaches that various dyes may be utilized it would have been obvious to utilize any well known dye in the composition of the reference absent evidence showing otherwise. As for claim 21 this is not a required component as it is merely clarifying what component (2b) may be selected from. As for claim 22 this is met by the reference as the reference suggests mixtures of anionic and cationic dyes. Claims 26-27 are met by the reference as the reference teaches the formation of an aqueous ink vehicle composition.

***Allowable Subject Matter***

12. Claims 23-25, 28-37, 41 and 44-45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all



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of the limitations of the base claim and any intervening claims and provided that any claim objection or 112 rejections are overcome.

***Information Disclosure Statement***

13. The references that were initialed have been considered by the examiner. Those not initialed have not been considered as copies of these foreign documents and/or abstracts have not been submitted. If applicant wishes them to be considered then copies should be submitted along with another IDS listing them.

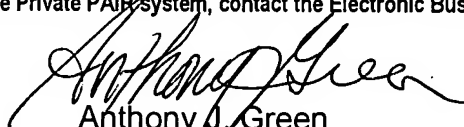
***References Cited By The Examiner***

14. The references are cited as showing the general state of the art and as such, they are not seen to teach or fairly suggest the instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Anthony J. Green  
Primary Examiner  
Art Unit 1755

ajg  
June 08, 2005